

REMARKS

As explained in the MPEP § 2001.06, Applicant points out to the Examiner that the Applicant has several co-pending applications in same general art: 10/015,314, 10/211,063, and 10/418,829 (Collins, Examiner).

Abstract

The abstract has been amended to explain more clearly the invention and to correspond more precisely to the Figures. No new matter has been added because the amendment explains precisely what has been in the Figures since the filing date.

Specification

The specification has been amended to explain more clearly the invention, to correspond more precisely to the Figures and to correct for some typographical errors. No new matter has been added because the amendment explains precisely what has been in the Figures since the filing date.

General Remarks

In the June 30<sup>th</sup> 2004 Office Action, the Examiner indicated that the finality of the last office action was withdrawn, but that Applicant's previous arguments "are moot in view of the new ground(s) of rejection."

The only new prior art reference that has been applied in this Office Action that has not been applied in previous Office Actions is Needler (D301,592). In particular, the Examiner cited Needler under Section 102(b) as allegedly anticipating

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Applicant's claim 1. The Examiner has also rejected claims 2, 3, 5, 13, and 18-25 under Section 103(a) citing additional references Hoyt et al., Stanton and Moody, all in combination with Needler.

All other applied references had been previously cited and, as previously explained, and explained again below, are totally irrelevant to the claimed inventions.

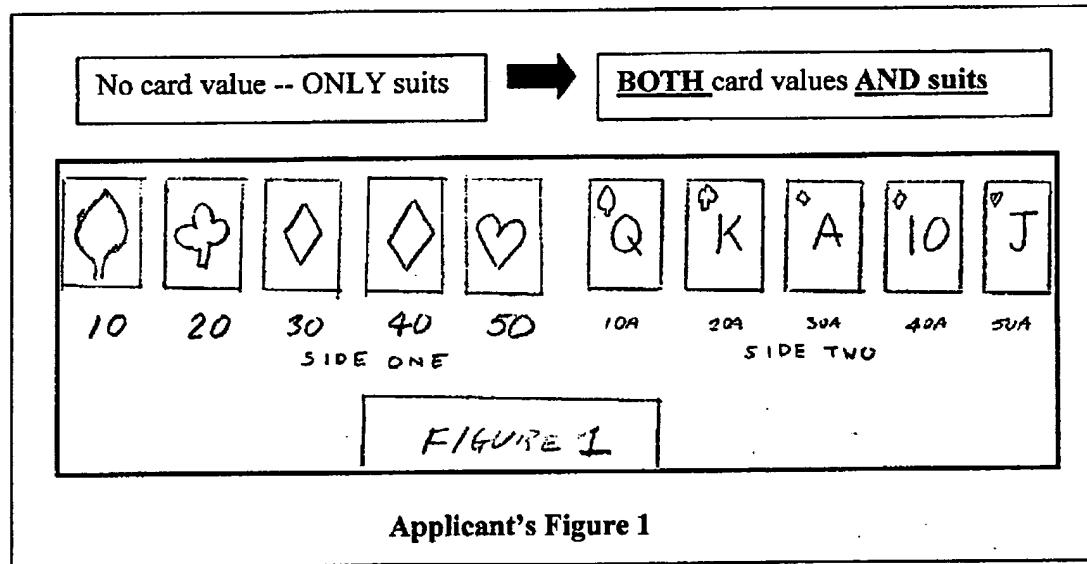
Applicant respectfully observes that the Examiner continues to overlook the fundamental difference between the inventions and the prior art -- the card's suit and the card's value (i.e., ace, 10, queen, etc.) are SEPARATED when the card is first dealt. Only the card's suit appears when the card is first dealt. No other card has this novel property. It is also important to understand that the term "card value" relates exclusively to the cards' rank in the deck: 2, 3, 4, 5 . . . to Jack, Queen, King, Ace. A numeral "2," that denotes a particular group of cards that does not correspond exclusively to the card's rank is not a card value.

The second novel property of the cards of this invention is that the appearance of the cards CHANGES as the game is played from providing partial information about the card (i.e., the suit alone) to providing complete information about the card (i.e., both the card's suit and the card's value). Applicant's cards when dealt show ONLY the suit -- and not the card value. No other card has this property. When the player selects the card, the appearance of the cards CHANGES to show BOTH the suit and card value.

No other card in the prior art has these properties and no prior reference suggests these properties. All claims include this innovation and new claims 30 and 31 explicitly spells this out that the appearance changes.

It bears repeating all other prior art playing cards are static -- that is, they do not change as they are played, they have a front, which shows the suit AND the card value, and a back that has NO INFORMATION ABOUT THE CARD'S SUIT OR THE CARD'S VALUE.

Applicant's Figure 1 (reproduced below) shows the dynamic change of his invention. When the cards are first dealt they display only the suit. This is shown on the left side of the figure above "Side One."



When the player selects the cards, the cards change their appearance. This is shown on the right side of the figure (side two) where both the card's suit and the card's value are displayed. The Examiner is urged to compare the left side of Figure 1 with the right side of Figure 1 to see the fundamental difference between the cards' appearance. Side one has no card value. Side two has both the card value and the suit. This significant, and completely unique distinction alone is enough to separate the prior art from the claimed inventions.

Claim 1 - Section 35 USC § 102

Claim 1 was rejected under 35 USC § 102(b) as allegedly being anticipated by Needler. The Examiner stated: "Needler teaches cards that display a suit on one side (e.g. clubs) and both a suit and value on the other side." Applicant respectfully disagrees with Examiner's conclusion.

Needler

Needler's patent is a design patent that is described in his claim as "the ornamental design for a playing card." Design patents protect only ornamental features. 35 U.S.C. § 171 and MPEP ¶ 1504.01(c). Thus, Needler's design cannot affect the function of the cards.

Needler -- like virtually all prior art references -- has a non-descriptive or decorative (i.e., ornamental) back so that the cards can be dealt face down. Needler chose to use a design that looks like a club pattern. However, that pattern is not related to the card's suit; the suit is shown on the reverse side of Needler's cards. The Examiner is requested to look at Needler's Figures 1 and 2 (reproduced below) -- that show the card with the club pattern on its back is an Ace of Spades. Thus, the design on Needler's card back is completely irrelevant to the card's suit. The design looks like a club -- but the card shown is a spade.

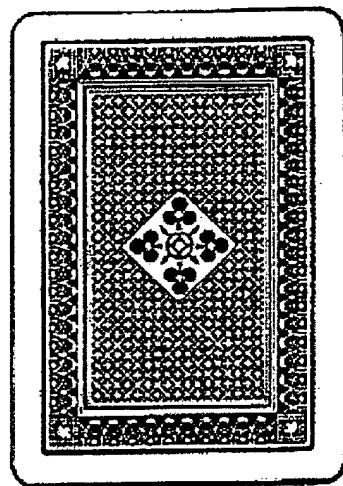


FIG. 1

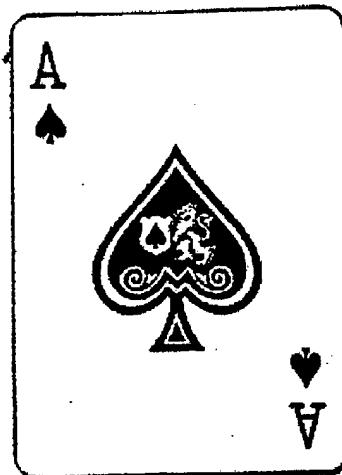


FIG. 2

**Needler Figures 1 and 2**

Moreover, Needler's ornamental design (which admittedly looks like a club) would be the same for all 52 cards in the deck regardless of what the card's suit is. No person of ordinary skill in the art would equate the design on Needler with the card's suit (see Declaration of Jon Hafezi, ¶ 7, filed on September 22, 2004)

Needler is a conventional playing card that has a non-descriptive back with a design that happens to look like a club. Unlike Applicant's cards -- Needler's cards do not change their appearance -- and Needler's cards do not SEPARATE the card's suit and the card's rank. In Needler, the card's suit (spade) and card's rank (Ace) ARE BOTH ON THE SAME SIDE OF THE CARD, and always appear together (see Figure 2 above).

Claim 1 and the other independent claims have been amended to even more clearly state that the only the indicium that appears when the card is first dealt is the

card's suit. Any arbitrary suit is insufficient. Needler does not, and cannot, display the card's suit separately from the card's rank. Both are ALWAYS displayed together.

Conventional cards -- like Needler -- are an all or nothing proposition. In Needler when the card is dealt face down, a player has no information about the card. When the card is turned over the player has all the information about the card (i.e., both the suit and card rank). So, Needler goes from zero information to complete information.

The differences between Needler and the Applicants' inventions are stark, direct and overwhelming. Needler has nothing whatsoever to do with the Applicants' inventions.

### Claim 2

Examiner has rejected claim 2 as being "unpatentable over Needler, in view of Hoyt, et al." Claim 2 has been withdrawn.

### Claims 3 and 5

The Examiner stated:

"Stanton discloses Improvements in and relating to Playing cards. Stanton teaches cards with [sic, indicia(?)] arranged into four suits on one side and values on the other side (page 1, lines 14-24 & figures 1-4).

It would be obvious in view of Stanton to arrange the card[s] to add excitement to the game played by the players."

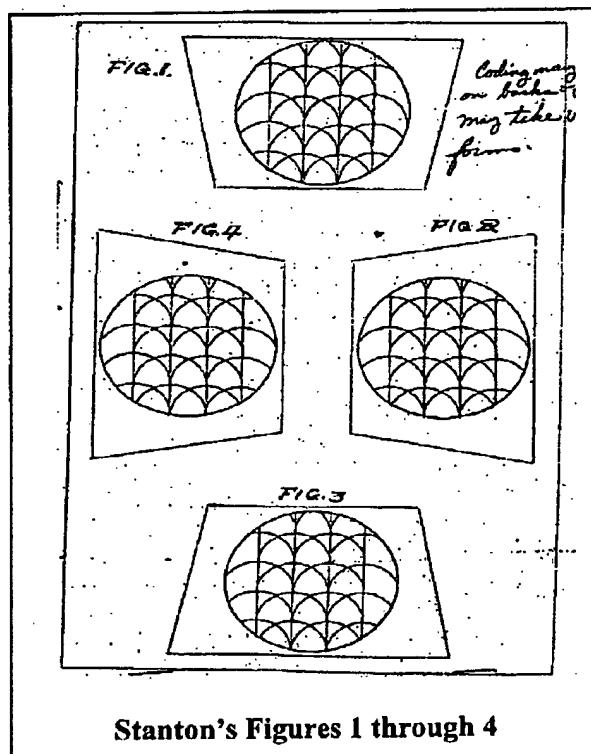
For clarity, Applicant has reproduced Stanton lines 14 to 24 to demonstrate that nothing in Stanton describes or suggests using card values, or the card's

suit, on the cardbacks. Instead, Stanton discusses printing colors and designs on cardbacks to identify card sets, each comprised of cards from multiple suits:

"According to this invention, I arrange the complete set of cards, *i.e.*, the four suits, into four sets each set having cards of equal value, and so mark, print, brand, denote or otherwise or otherwise distinguish the four sets that, in dealing, each player will receive one of the sets of cards. The distinguishing of the cards may be variously modified as desired, it may be done by printing the backs of the cards in different colours, by applying distinguishable advertisements, or by printing different designs, one on each set.

In arranging say, an ordinary set or pack of playing cards each distinctive set will consist of the following cards; *viz:* Ace, ten, six and two (deuce) of one suit ; king, nine and five of another suit; queen, eight and four of another suit, and knave, seven and three of the last suit." (Emphasis added)."

This passage does NOT mention anywhere, that a card value, of any type, is printed on the cardbacks. Stanton's Figures are reproduced below. The Examiner states that they show "four suits on one side and values on the other side."



These Figures show neither suits nor card values (or values of any kind).

The Examiner's conclusion, therefore, is wrong. Stanton simply does not separate the card's suit from the card's value, and neither suit nor value is displayed separately on the card back.

The Stanton patent's reference to card backs is unlike the cards of the pending application because they affect the distribution of cards prior to the start of a game and are not related to the suit or card value of individual cards. (Hafezi Dec. ¶ 8). Moreover, the appearance of Stanton's cards does not change (other than from a face down to a face-up card) during the course of play.

Furthermore, Stanton's cards do not ever display the suit alone and, therefore, do not have the limitation of claim 3 "where the only one of the indicia that appears on one or more of the cards when dealt is the card's suit" or the limitation of claim 5 "when dealt, the only one of the indicia that appears on one or more of the cards is the card's suit." By contrast, in Stanton card suits and card values ALWAYS appear together on the same side of the cards in Stanton. Any other interpretation of Stanton is simply incorrect.

Stanton's card backs are very different than the appearance of Applicant's cards when first dealt; they give no indication whatsoever of the card's rank (i.e. the card's value) or its suit. This point is made clear as stated in Stanton's 1<sup>st</sup> Claim: "Playing cards as described...will enable anyone without previous knowledge of cards, to deal these cards quickly and accurately into four groups or sets of equal value without knowing or seeing the faces of any card." (Emphasis added). If, in fact, Stanton's card back provided the suit on the back side, this statement could not be true.

With respect to Hoyt, the Examiner states "Hoyt teaches game [sic] of poker played as one of the embodiments and that his cards are dealt certain locations and specific to the game of Tic-Tac-Toe," and also adds "It would be further obvious in view of Hoyt to include his explicit [?] to add excitement to the game played by the players."

Hoyt adds nothing to Needler and Stanton. As the Examiner stated, "his cards are dealt certain locations and specific to the game of Tic-Tac-Toe." This card arrangement is very different from and, as a 3 X 3 matrix pattern, teaches away from the 12 card diamond pattern of claim 3 and shown in Figure 3 of Applicant's specification. Moreover, currently amended claim 5 contains no reference to locations of where cards are dealt. There is also nothing "explicit to add [sic]" in Hoyt that is relevant to Applicant's invention.

Furthermore, Hoyt's specification makes no mention of any card back, other than a conventional one, anywhere. Plainly, Hoyt's cards are not the same or remotely similar to Applicant's novel cards.

Even if all of the cited references were combined, they would not yield the applicant's inventions because none of these references separate a card's suit from its value when first dealt as in Applicant's invention, nor do any suggest doing so.

#### Claims 13 and 19

Examiner states that "Needler teaches cards that display a suit on one side (e.g. clubs) and both a suit and value on the other side." The Examiner also states that "Moody discloses an Electronic Video Poker Game, which deals multiple rows" and "it would have been obvious to one of ordinary skill in the art at the time the invention was

made to modify Needler, not only to play poker games, to include an electronic version to add options and generate excitement for the players."

As Applicant has explained above, Needler does not teach a suit on one side separate from the card value; his card back provides no information relevant to any card, and is only an ornamental design for cards. Needler's cards are conventional cards with a club shaped design on the non-descriptive card back.

Therefore, combining Needler and Moody would only yield Moody's game.

Combining these references would not yield the Applicant's invention because the following claim element of Claim 13 is completely missing:

"a when the cards are dealt, the only one of the indicia that appears on each card is the card's suit[.]"

The resulting combination would also be missing the following claim element of claim 19:

"and the only one of the indicia that appears on each card is the card's suit[.]"

Thus, the resulting combination of these references would not yield the claimed inventions or anything close to the claimed inventions.

#### Claim 18

Examiner states "Moody discloses an Electronic Video Poker Game, which deals multiple rows." However, Moody does not disclose a game where more than five cards are dealt at one time. Instead, Moody repeats identical five-card hands multiple times. In Moody's game, the cards are "duplicated" from one hand to another.

(See col. 1, lines 22-24). They are not additional cards dealt from the deck, nor does the player select from more than five cards to build a five card hand as in Applicant's Claim 18. Lastly, Moody does not disclose cards where the suit alone is displayed as in Claim 18.

As explained above Needler does not disclose anything resembling the claimed inventions. Therefore, combining Needler and Moody does not result in the claimed invention of Claim 19. (Hafezi Dec. ¶ 7 and 12-13)

#### Claim 20

Applicant's arguments with respect to Needler and Hoyt as mentioned above apply to Claim 20 as well.

Moreover, the Examiner's statement that Needler "fail[s] to explicitly teach cards with a non-descriptive back" is not true. The backs of Needler are ornamental (as required by the design patent statute) -- and provide no information whatsoever about the card's suit or the card's value. Simply put, Needler's card backs are non-descriptive. (Hafezi Dec. ¶ 7)

Even if Needler, Hoyt and Moody were combined, they would not have the element of claim 19 referred to above (see Hafezi Dec. ¶ 7 and ¶ 12-13) from which claim 20 depends.

Thus, the resulting combination is not the claimed invention and the obviousness rejection is improper because, as stated in MPEP § 2143.03, "All claim limitations must be taught or suggested."

Claim 21 - Section 35 USC § 103

Examiner cites Needler and states "It would be obvious to deal cards in whatever shape that is desired since shape would constitute a design issue. Additionally, the dealing of cards in various shapes is well known in the art (e.g. in the game of *Memory* cards are dealt in the shape of a square, in the game of *Solitaire*, cards are ultimately dealt in the shape of a triangle."

Needler has nothing to do with how cards are dealt, played, or arranged. Moreover, the arrangement of cards can be critical to how a game is played.

The Examiner's conclusion is based on the faulty premise, as explained above, that Needler discloses cards that when first dealt display the cards' suit alone. As explained above, this is incorrect, and the invention of Claim 21 would not have been obvious in view of Needler. (Hafezi Dec. ¶ 7 and 12-13)

Claims 4 and 22 - 25 - Allowable Subject Matter

The Examiner indicated that claims 4 and 22 to 25 would be allowable if rewritten in independent form. Claim 22 is (and was) in independent form and should be allowed. Independent claim 3, from which claim 4 depends, has been amended, as has claims 24. Applicant believes these claims are still allowable.

No additional fee is required.

Conclusion

For the foregoing reasons, the Applicant submits that the Examiner's rejection of the claimed invention was incorrect and the claims should be allowed.

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Respectfully submitted,



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Abstract

This patent relates to novel playing cards where each card has, associated with that card, indicia comprising a suit and a value, and games that can be played with those cards. When the novel cards are initially dealt, have the of the two indicia, only s the card's suit appears on each card, on one side and the card's value on the other. Thus, when they are dealt, the player will know the suit of some or all the cards in his hand, but will not know the value. When the player selects a card, the indicia that appear on the card are both the card's suit and the card's value.

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Specification

Please replace the second and fifth paragraphs on page 1 of the specification as follows:

Paragraph 2

The difference between the current invention and prior art playing cards is the suit is displayed on one side of the card and the card's value and the card's suit is on the other side. This configuration allows cards to be dealt so that the suit is displayed, but the value of the cards is not. This gives the player some additional information about his odds of winning and may help determine the value of his bet.

Paragraph 5

Another version of the invention allows some of the cards to have traditional, non-descriptive backs and some cards have the novel cards with the suit on one side and the card's value and the card's suit on the other side, which I will refer to as split representation. In the video version of these games where only some of the cards that have the split representation, the cards could be changed ~~cards~~ from one game to the next to prevent the player from getting an unfair advantage. For example, if the seven of spades used a traditional representation (i.e., suit and value on the same side) in one game it could be changed in the next hand so that spades was shown on one side and the seven and spades was shown on the other.